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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,007	02/08/2005	Stefan Koller	HM/15-22735/PCT	9480
324	7590	11/25/2008	EXAMINER	
JoAnn Villamizar			HOLLOMAN, NANNETTE	
Ciba Corporation/Patent Department				
540 White Plains Road			ART UNIT	PAPER NUMBER
P.O. Box 2005				1612
Tarrytown, NY 10591				
			MAIL DATE	DELIVERY MODE
			11/25/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/524,007	KOLLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	NANNETTE HOLLOWMAN	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 July 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 3-11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

    1. Certified copies of the priority documents have been received.

    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

This Office Action is in response to the Amendment filed on July 07, 2008. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### ***Claim Rejections - 35 USC § 102 (Previous Rejection)***

Claims 1-6 and 9-11 were rejected under 35 U.S.C. 102(b) as being anticipate by Struillou et al. (EP0771785). This rejection is withdrawn from claim 2. This rejection is maintained.

### **Applicant's Arguments**

Applicant argues there is no mention of a reaction of a halo ester with a heterocyclic aromatic amine to produce a water soluble ester involving a reaction at the aromatic amino nitrogen. Applicant further argues that the pyridine and dimethylamino pyridine (DMAP) are used only to assist in the reaction for forming the halo-ester.

### **Examiner's Response**

In regard to the reaction of a halo ester with a heterocyclic aromatic amine to produce a water soluble ester involving a reaction at the aromatic amino nitrogen and that the pyridine and dimethylamino pyridine (DMAP) are used only to assist in the reaction for forming the halo-ester, Struillou et al. disclose the same reaction with the same conditions as claimed. It would be inherent that the same reaction with the same

reagents would form the same product. Applicant's claims do not recite the actual mechanistic steps of the reaction as argued on p. 5, and therefore the reference does not have to disclose the argued mechanistic steps.

***Claim Rejections - 35 USC § 103 (New Rejection)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koller et al. (US Patent No. 4,083,847, previously disclosed) further in view of Shibata et al. (U.S Patent No. 5,958,084).

Koller et al. discloses a method for the controlled release of a biologically active hydroxyl group containing substance. Koller et al. teaches a method of reacting a dye that contains a hydroxy group with a halogen- substituted aliphatic carboxylic acid halide, chloroacetyl chloride, forming a halogenoacetate ester and reacting said chloracetic ester molecule with a diamine (column 16, line 62 and column 24, lines 3-7). Chloroacetyl chloride is a known acetyl chloride. Koller et al. discloses a solution of a dye containing a hydroxy group, chloroacetyl chloride, and N, N, N', N-tetramethylethylenediamine (Example 4, column 27, lines 1-30). The N, N, N', N-tetramethylethylenediamine is the same compound as claimed (See the Material Safety Data Sheet, printed 02/05/2004, section 2- Composition/Information on Ingredient, Formula synonyms, compounds 1 and 6, previously disclosed). Koller et al. also discloses applying the dye to the textile fiber followed by hydrolysis of the carbacyl group, which is the ester group (column 2, lines 23-24). Koller et al. disclose dye stuffs that are known in the cosmetic art, i.e. azo dye.

Koller et al. do not disclose wherein the biologically active hydroxyl group containing substance is a drug, plant protective agent, insecticide, antimicrobial, flavoring agent or cosmetic.

Shibata et al. disclose a permanent hair dyeing composition (Abstract). Shibata et al. disclose addition of acid dye in the hair composition makes it possible to uniformly disperse the dye in a large amount and hair can therefore be evenly coated with the dye, so that the dyability can also be improved.

Shibata et al. do not disclose the method of instant claim 1.

It would have been obvious to one of ordinary skill to use the method of Koller et al. to make a cosmetic dye motivated by the desire to form a hair dye that makes it possible to uniformly disperse the dye in a large amount and therefore the hair can be evenly coated with the dye, so that the dyability can also be improved as disclosed by Shibata et al.

Alternatively it would have been obvious to make the dyes of Shibata et al. with the methods of Koller et al., motivated by the desire to use a process for making dyes disclosed in the art that do not require the use of poisonous, effluent polluting dispersants and do not cause troublesome foaming as disclosed by Koller et al. (col. 24, lines 57-65).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612